

**REMARKS**

The Application presently includes claims 1-3, 5-9, 12, 14-16, and 18. Claims 1-3 were rejected by the Examiner under 35 U.S.C. §103(b) as being unpatentable over Swash, U.S. Patent No. 5,637,044 (“Swash”), in view of Yamaguchi et al., U.S. Patent No. 4,792,140 (“Yamaguchi”) and the Rules of Golf as set forth by the USGA, as set forth in the Office Action dated April 9, 2003. Claims 5-12, 14-16, and 18 were also rejected by the Examiner under 35 U.S.C. §103(a) as being unpatentable over Swash in view of Yamaguchi, the Rules of Golf, and Igarashi, U.S. Patent No. 5,437,088 (“Igarashi”), as set forth in the Office Action dated April 9, 2003. No new matter has been added. Applicant respectfully traverses the rejections, and requests that the Examiner withdraw the objections and rejections and pass the application to allowance.

Claim 1 has been amended to include the limitation that face markings on the golf club head have a constant radius. Claim 2 has been amended to change the depth of the face markings from 50 microns to a range of depths of 0.05mm to 0.1mm. Claim 5 has been amended to correct an informality, specifically, a typographical error in the word located. Claim 6 has been amended to emphasize that the insert is spaced from the golf club head by a resilient means and that a clearance space is formed between the insert and the head. Claim 9 has been amended to correct an informality, specifically, a typographical error in the word machined. Claim 15 has been amended to have the same depth limitations as amended Claim 2. Claim 16 had been amended to include the limitation that face markings on the golf club head have a constant radius. Claims 10 and 11 have been cancelled. No new matter has been added.

**Claim Rejections under U.S.C. § 103(a) of Claims 1-3, 5-9, 12, 14-16, and 18**

The rejections of claims 1-3, 5-9, 12, 14-16, and 18 under 35 U.S.C. 103(a) are respectfully traversed.

**1. Rules of Golf are Non-Analogous Art**

In the Office Action dated April 9, 2003, the examiner conceded that Swash “differs from the claimed invention in that Swash does not show a groove depth being of micron size.” The examiner then went on to rely on the Rules of Golf to teach a range of groove depths between zero and 0.5mm. Applicant respectfully submits that the Rules of Golf are non-analogous art and, therefore, cannot be properly combined with Yamaguchi. The test for determining whether art is analogous is whether the reference is “in the field of applicant’s endeavor or, if not then is reasonable pertinent to the particular problem with which the inventor is concerned.” MPEP 2141.01(a) quoting In re Oetiker, 24 U.S.P.Q.2d 1443, 1445 (Fed. Cir. 1992). It is noted that the definition of “endeavor” is “activity towards a goal,” as shown by the enclosed excerpt from the Merriam-Webster OnLine dictionary. The field of endeavor, or goal, of the particular problem the applicant is seeking to solve is to produce a golf club or putter with particular markings that have a particular effect on a struck ball. In contrast, to this, the intention of the Rules of Golf is to regulate the playing of the game of golf. The rules of Golf are not set out to produce anything. The problems dealt with by the Rules of Golf involve intellectual information; they do not produce any hardware. At most, the Rules of Golf can be said to regulate golf club dimensions. However, regulating golf club dimensions does not give any guidance to a golf club designer interested in improving golf club performance while remaining within the regulations. Accordingly, applicant respectfully submits the Rules of Golf are non-analogous art and thus should not be used in determining the patentability of applicant’s invention.

**2. Yamaguchi Cannot Properly be Combined With the Other References**

**A. Yamaguchi Teaches Omitting of Grooves**

With regard to Yamaguchi, in the Office Action dated April 9, 2003, the examiner stated on page 3, “The skilled artisan further finds from a reading of Yamaguchi that the omission of grooves is desirable in that without face grooves, the trajectory angle of a struck ball is increased, the degree of spin experienced by the ball at impact is reduces and the amount of ball carry is increased over a conventional striking face that is provided by grooves.” Citing Yamaguchi, Col. 5, Lines 49-75. Applicant’s invention uses face grooves of micron size. This is in direct contravention to the

teaching of Yamaguchi. Thus the skilled artisan would have no motivation to golf club face grooves according to applicant's invention when considering Yamaguchi.

**B. Yamaguchi Insert Material Cannot Be Extricated from Groove Selection**

Furthermore, Applicant respectfully directs Examiner's attention to Yamaguchi, column 5, lines 49-55, which state: "It is clearly known that striking faces fabricated from material as ABS or ionomer resin and provided without face grooves serve to increase the trajectory angle, reduce the degree of spin, and increase the carry of ball more than the conventional type striking face." Further reference to Yamaguchi shows that an essential part of the Yamaguchi invention is the provision of a member made of material lower in compression Young's modulus as compared with steel. Accordingly, the Yamaguchi invention is not merely the provision of grooves or no grooves, but is inextricably bound up with the provision of a face insert having a Young's modulus lower than steel. This is in contrast to applicant's invention which does not require such selection of materials. Again, the skilled artisan would have no motivation to golf club face grooves according to applicant's invention when considering Yamaguchi.

**C. Yamaguchi Does Not Teach Groove Patterns According to Applicant's Invention**

The examiner further states: "Moreover, Yamaguchi guides the skilled artisan to form groove patterns in other than conventional patterns. Thus the applicant's claim to 'non-concentric groove patterns' is obviated by the Yamaguchi teaching." Applicant acknowledges that Yamaguchi teaches other than convention groove patterns, such as groove patterns across the sweet spot, grooves across the sweet spot, grooves at the side of the sweet spot, grooves below the sweet spot, etc. However, reference to Y amaguchi s hows t hat a ll e xamples of grooves are constituted by **parallel** lines. Moreover, there is no teaching or suggestion in Yamaguchi of groove depth other than zero depth, that is, a plain face. Again, the skilled artisan would have no motivation to golf club face grooves according to applicant's invention when considering Yamaguchi.

**D. Swash and Yamaguchi Cannot Properly be Combined**

Yamaguchi cannot properly be combined with either the Rules of Golf or Swash. “Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art.” MPEP 2143.01. Applicant respectfully points out that there is no suggestion of curved grooves in either the Rules of Golf or Yamaguchi. Only Swash teaches curved grooves and the examiner is on record as stating that Swash does not show groove depth of micron size. Moreover, applicant would point out as taught in applicant’s original disclosure a page 5, lines 22-26, the curvilinear, non-concentric, constant radius markings (as now called for in amended Claims 1 and 16) present the same configuration to the golf ball as it moves relative to the putter face during the stroke. This is in contrast to the marking of Swash where the grooves radiate from a common center point, which result in presenting differing configurations to the ball. Therefore, there is no motivation to combine the cited references, even if they were combinable, in such a manner as to render applicant’s invention obvious.

**3. Simplicity of Applicant’s Invention Does Not Make Applicant’s Invention Obvious**

The examiner rejects claims 5-9 stating: “In view of the patent to Yamaguchi, it would have been obvious to modify the device ... in Swash by attaching a separate face plate to the club head ... to simply provide another convenient manner of incorporating grooves within the club face. The fact that applicant requires the insert be made from cast or bar stock material does not patentably distinguish over the prior art teachings.” Applicant respectfully submits the examiner is confusing simplicity of invention with obviousness. Simplicity of invention is discussed in In re Nomiya, 509 F.2d 566, 184 U.S.P.Q. 607 (CCPA 1975): “In a few instances, an inventor may have recognized an unforeseen problem that was not recognized by others. Once recognized, it may well be that the solution is obvious. However, despite the simplicity of that solution the consequent invention may nevertheless be held patentable.” The examiner is respectfully requested to view Figs. 3, 4, and 11 of Yamaguchi and consider the complex machining techniques required to produce these tapered

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Amdt. Dated March 30, 2004  
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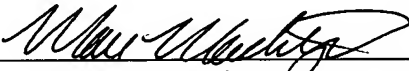
dovetail embodiments and then compare these with the simplicity of applicant's invention which merely requires the forming of a clearance hole and the use of unmachined (except for face markings) bar of cast stock. Thus, the simplicity of applicant's invention does not make applicant's invention obvious.

### **Conclusion**

In view of the above Amendments and Remarks, Applicant submits that the present application is in condition for allowance, and seeks early indication of the same. If the Examiner requires further information with respect to this application, the Examiner is invited to contact Applicant's attorney at (847) 537-3537 for a telephonic interview.

Respectfully submitted,

Date: March 30, 2004


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Main Entry: <sup>2</sup>**endeavor**

Function: *noun*

1 : serious determined effort

2 : activity directed toward a goal : ENTERPRISE <fields of endeavor>

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